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REMARKS

This is a full and timely response to the Office Action of January 23, 2004. Upon entry of this Fourth Response, claims 1-9 remain pending in this application, and claims 1, and 7- 9 are directly amended herein. Further, claim 10 is newly added. It is believed that the foregoing amendments and additions add no new matter to the present application.

If the Examiner has any questions or comments regarding Applicant's response, the Examiner is encouraged to telephone Applicant's undersigned counsel.

101 Rejections

Claims 7-9 have been rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. It is stated in the Office Action that the computer system programmed to perform the recited steps "fails to be tangibly embodied on a computer-readable medium so as to be executable."

Although Applicant believes that independent claim 7 and dependent claims 8 and 9 as originally filed, do recite statutory subject matter, Applicant has amended each of independent claim 7 and dependent claims 8 and 9 as indicated by the Office Action rejection.

The amendments of claim 7-9 were made merely to expedite prosecution of the present application and early allowance of the claims. Applicant believes that no substantive limitations have been added to the claims by these amendments and therefore no prosecution history estoppel arises from these amendments. *Black & Decker, Inc. v. Hoover Service Center*, 886 F.2d 1285, 1294 n. 13 (Fed. Cir. 1989); *Andres Corp. v. Gabriel Electronics, Inc.*, 847 F.2d 819 (Fed. Cir. 1988); *Hi-Life Products, Inc. v. American National Water-*

Mattress Corp., 842 F.2d 323, 325 (Fed. Cir. 1988); *Mannesmann Demag Corp. v. Engineered Metal Products Co., Inc.*, 793 F.2d 1279, 1284-1285 (Fed. Cir. 1986); *Moeller v. Ionetics, Inc.*, 794 F.2d 653 (Fed. Cir. 1986).

Applicant respectfully submits that the 35 U.S.C. § 101 rejection of claims 7 and 9 should now be withdrawn.

102 Rejections

It is well established that "[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under consideration." *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983).

Claim 1

Claim 1 presently stands rejected under 35 U.S.C. 102 as allegedly anticipated by *Wilson* and as allegedly anticipated by *Mayhew*. Claim 1 reads as follows:

> 1. In an iconic programming system, wherein the iconic programming system contains an existing network of connected icons, a computer-implemented method for tracing the execution of icons, the method comprising the steps of:
>
> executing a plurality of the icons via a run of a software program;
>
> setting a flag for each icon executed in the executing step, the flag corresponding with the each icon; and
>
> ***simultaneously highlighting each icon corresponding with each flag set in the setting step subsequent to the run of the software program.***
>
> (Emphasis added).

Applicant respectfully submits that *Wilson* or ***Mayhew*** fails to disclose at least the features of claim 1 highlighted hereinabove.

In this regard, *Wilson* appears to disclose a system that "receives the address of the instructions being executed and identifies this address to a displayed icon to modify the icon thus indicating the internal operation of the program on a **real time basis**." See *Wilson*,

Abstract. (Emphasis added). *Wilson* goes on to disclose that "[a]s the motion control program runs **in real-time**, the visual aspect of the icons is modified to provide a direct and immediate indication of the internal operation of the control program." See *Wilson*, column 2, lines 43-47. (Emphasis added). Further, *Wilson* discloses that "[m]odifying the icons **in synchrony with** the running of the control program may be accomplished by periodically polling the motion controller to provide an indication of the address of the portion of the control program currently being executed." See *Wilson*, column 3, lines 6-10. (Emphasis added).

However, it does not appear that *Wilson* discloses "simultaneously highlighting each icon corresponding with each flag set in the setting step **subsequent to the run of the software program,**" as claimed in claim 1. (Emphasis added).

Furthermore, *Mayhew* appears to disclose a system that:

> "[d]uring the application program procedure, the presentation of a graphical icon is modified to indicate a readiness of an associated job to execute. Thereafter, the user selects the associated job for execution by entering a selection signal. The graphical icon's presentation is modified to indicate completion of execution of the associated job and the presentations of one or more connectors are modified to indicate a completion of execution."

See *Mayhew*, Abstract; column 2, lines 14-22. Specifically, *Mayhew* discloses that after a task is run, "the icon associated with the task ...is successively changed to indicate the current status of the task." See *Mayhew*, columns 4, lines 46-48. Thus, it appears that, like *Wilson*, *Mayhew* highlights icons at run-time and, in particular, does not appear to highlight a plurality of icons after the plurality of icons have been executed.

Accordingly, *Mayhew* also does not appear to disclose a system for "simultaneously highlighting each icon corresponding with each flag set in the setting step subsequent to the run of the software program," as claimed in claim 1. (Emphasis added).

For at least the aforedescribed reasons, Applicant submits that *Wilson* and *Mayhew* fail to disclose each feature of pending claim 1, and the rejection to claim 1 under 35 U.S.C. 102 should be withdrawn.

Claim 2

Claim 2 is presently stands rejected as unpatentable under 35 U.S.C. §102 as allegedly anticipated by *Wilson* and *Mayhew*. Dependent claim 2 contains all features of its respective independent claim 1. Since claim 1 should be allowed, as argued hereinabove, pending dependent claim 2 should be allowed for at least this reason. *In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

Claim 3

Claim 3 presently stands rejected under 35 U.S.C. 102 as allegedly anticipated by *Mayhew*. Claim 3 reads as follows:

> 3. In an iconic programming system, wherein the iconic programming system contains an existing network of connected icons, a computer-implemented method for tracing the execution of icons, the method comprising the steps of:
>
> executing a plurality of the icons;
>
> setting a flag for each icon executed in the executing step, the flag corresponding with the each icon;
>
> ***receiving an input subsequent to the executing step;*** and
>
> ***simultaneously highlighting, in response to the receiving step, each icon corresponding with each flag set in the setting step.*** (Emphasis added).

Applicant respectfully submits that ***Mayhew*** fails to disclose at least the features of claim 3 highlighted hereinabove.

As argued hereinabove with respect to claim 1, *Mayhew* appears to disclose a system that:

> "[d]uring the application program procedure, the presentation of a graphical icon is modified to indicate a readiness of an associated job to execute. Thereafter, the user selects the associated job for execution by entering a selection signal. The graphical icon's presentation is modified to indicate completion of execution of the associated job and the presentations of one or more connectors are modified to indicate a completion of execution. "

See *Mayhew*, Abstract; column 2, lines 14-22. Specifically, *Mayhew* discloses that after a task is run, "the icon associated with the task ...is successively changed to indicate the current status of the task." See *Mayhew*, columns 4, lines 46-48. Thus, it appears that, like *Wilson*, *Mayhew* highlights icons at run-time and, in particular, does not appear to highlight a plurality of icons after the plurality of icons have been executed.

However, *Mayhew* does not appear to disclose "receiving an input **subsequent** to the executing step" and "simultaneously highlighting, in response to the receiving step, each icon corresponding with each flag set in the setting step," as claimed in claim 3. (Emphasis added).

Accordingly, Applicant submits that the cited art fails to disclose at least the features of claim 3 highlighted hereinabove. Thus, Applicant submits that the rejection of claim 3 should be withdrawn.

Claim 4

Claim 4 presently stands rejected under 35 U.S.C. 102 as allegedly anticipated by *Mayhew*. Claim 4 reads as follows:

> 4. In an iconic programming system, wherein the iconic programming system contains an existing network of connected icons, a computer-implemented method for tracing the execution of icons, the method comprising the steps of:
>
> executing a plurality of the icons;
>
> indicating which of the icons are executed in the executing step;
>
> ***determining, subsequent to the executing step and based on the indicating step, that the plurality of icons have been executed; and***
>
> ***highlighting the plurality of executed icons in response to the determining step.*** (Emphasis added).

For at least the reason set forth hereinabove with reference to claim 3, Applicant respectfully asserts that *Mayhew* fails to disclose at least the features of claim 4 highlighted hereinabove. Thus, Applicant respectfully submits that the rejection of claim 4 is improper and should, therefore, be withdrawn.

Claims 5 and 6

Claims 5 and 6 presently stands rejected under 35 U.S.C. §102 as allegedly anticipated by *Wilson* and *Mayhew*. Dependent claims 5 and 6 contain all features of their respective independent claim 4. Since claim 4 should be allowed, as argued hereinabove, pending dependent claims 5 and 6 should be allowed for at least this reason. *In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

Claim 7

Claim 7 presently stands rejected under 35 U.S.C. 102(e) as allegedly anticipated by *Mayhew*. Amended claim 7 reads as follows:

> 7. An iconic programming computer system containing an existing network of connected icons, the system comprising:
> a display device; and
> logic configured to execute a plurality of the icons being displayed on the display device during a run of a software program and provide an indication as to which of the icons are executed during the run, ***the logic further configured to make a determination, subsequent to the run and based on the indication, that the plurality of icons have been executed and highlight the plurality of executed icons on the display device in response to the determination.*** (Emphasis added).

For at least the reasons set forth hereinabove in the arguments for allowance of claim 3, Applicant submits that the cited art fails to disclose at least the features of claim 7 highlighted hereinabove. Thus, Applicant submits that the rejection of claim 7 should be withdrawn.

Claim 8-10

Claims 8 and 9 presently stand rejected as unpatentable under 35 U.S.C. §102 as allegedly anticipated by *Mayhew*, and claim 10 is newly added. Dependent claims 8-10 contain all features of their respective independent claim 7. Since claim 7 should be allowed, as argued hereinabove, pending dependent claims 8-10 should be allowed for at least this reason. *In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

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CONCLUSION

Applicant respectfully requests that all outstanding objections and rejections be withdrawn and that this application and all presently pending claims be allowed to issue. If the Examiner has any questions or comments regarding Applicant's response, the Examiner is encouraged to telephone Applicant's undersigned counsel.

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Respectfully submitted,

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